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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,887	02/04/2004	Charles H. Perrone JR.	2108.003700	3884

45488 7590 09/12/2006

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EXAMINER

SCHILLINGER, ANN M

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,887	<b>Applicant(s)</b> PERRONE ET AL.	
	<b>Examiner</b> Ann Schillinger	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 29-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/17/04, 7/23/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of claims 1-28 in the reply filed on 8/15/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 29-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of insertion for the tibia base plate, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/15/2006.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, and 15-27 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (U.S. Pat No. 6,306,172). O'Neil discloses all of the following regarding claim 1: a device, comprising: a tibia base plate (78); an insert (86) adapted to be positioned above said base plate; and at least one removable pin (88) that, when installed, engages at least a portion of said insert and said base plate (in Figure 9A, pin 88 goes through both the insert and base plate)

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to thereby prevent relative rotation between said insert and said base plate (col. 7, lines 6-14; Figures 7A, 9A).

O'Neil also discloses all of the following regarding claim 15: a device, comprising: a tibia base plate (78); an insert (86) adapted to be positioned above said base plate; and a removable means (88) for preventing relative rotation between said insert and said base plate (col. 7, lines 6-14; Figures 7A, 9A).

O'Neil also discloses all of the following regarding claim 16: device of claim 15, wherein said removable means for preventing relative rotation between said insert and said base plate comprises a removable pin (88).

O'Neil discloses all of the following regarding claim 17: the device of claim 15, wherein said removable means for preventing relative rotation between said insert and said base plate comprises at least one removable pin (88) that, when installed, engages at least a portion of said insert and said base plate to thereby prevent relative rotation between said insert and said base plate (col. 7, lines 6-14).

O'Neil discloses claims 2 and 18 which state that the base plate is comprised of a metal in col. 1, lines 19-21.

O'Neil discloses claims 3 and 19 which state that the insert is comprised of a non-metallic material in col. 1, lines 32-34.

O'Neil discloses all of the following regarding claims 4 and 20: the device wherein said pin engages an opening formed in said base plate and engages an opening (102) formed in said insert (Figure 9A).

O'Neil discloses all of the following regarding claims 5 and 21: the device wherein said pin is located adjacent an anterior portion of said base plate (the bottom portion of 88 next to the anterior portion of base plate, 78).

O'Neil discloses the press-fit connection of claims 6 and 22 with an interference connection that works in the same manner as the press-fit connection (col. 6, lines 31-32).

O'Neil discloses all of the following regarding claim 7: the device of claim 1, wherein said pin has a head (106) that is positioned adjacent a bottom surface of said base plate (element 106 in Figure 9A is next to the bottom surface of base plate, 78).

O'Neil discloses all of the following regarding claim 8: the device of claim 1, wherein said pin has a shoulder (108) that is positioned adjacent a top surface of said base plate (element 108 in Figure 7A is next to the top surface of base plate, 78).

O'Neil discloses all of the following regarding claims 9 and 23: the device wherein a first portion (106) of said pin is configured to engage an opening formed in a side surface of said base plate (bottom portion of 102) and a second portion (104) of said pin is configured to engage an opening formed in a side surface of said insert (top portion of 102).

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O'Neil discloses all of the following regarding claims 10 and 24: the openings in said tibia base plate and said insert are formed on the anterior side surfaces of base plate and said insert, respectively (element 102 progresses through the anterior ends of 78 and 86).

O'Neil discloses all of the following regarding claims 11, 12, 25, and 26: the device wherein said pin has at least one of a circular, rectangular and square cross-sectional configuration and has a smooth exterior surface (col. 6, lines 22-23).

O'Neil discloses all of the following regarding claims 13 and 27: the device wherein said pin has at least one projection formed on an exterior surface of said pin (110 or 108; col. 6, lines 33-38).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. in view of Smith (U.S. Pat. No. 5,108,442). O'Neil et al. discloses that the various parts of the implant device can be made from a variety of materials including metals and non-metals (col. 1, lines 19-21). The reference, however, does not specifically disclose that the pin used in the implant is made of a metal. Smith teaches the metal pin of claims 14 and 28 in col. 3, lines 9-11.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use metal for the pin to accommodate for the knee's full range of motion and give the implant's pin its desired strength and durability.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger  
August 25, 2006

  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**